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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/939,526

08/24/2001

David J. Boothby

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2484

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7590

03/25/2011

Nokia Corporation and Alston & Bird LLP

c/o Alston & Bird LLP

Bank of America Plaza, 101 South Tryon Street

Suite 4000

Charlotte, NC 28280-4000

EXAMINER

VON BUHR, MARIA N

ART UNIT

PAPER NUMBER

2121

MAIL DATE

DELIVERY MODE

03/25/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/939,526	<b>Applicant(s)</b> BOOTHBY, DAVID J.	
	<b>Examiner</b> M.N. VON BUHR	<b>Art Unit</b> 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 and 24 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-49,51-55,57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49,51-55,57 and 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Examiner acknowledges receipt of Applicant's response to the previous Office action, received 24 February 2011; which submits a substitute reissue declaration and consent of assignee. Claims 1-49, 51-55, 57 and 58 are pending in this application.
2. Examiner acknowledges receipt, on 15 February 2011, of a copy of the preliminary amendment originally filed 26 July 2002, which cancelled claims 50 and 56, and amended claims 7, 30, 35, 40, 42 and 46. This amendment has been entered into the file.
3. In response to receipt of the substitute consent of assignee and statement under 37 CFR 3.73(b), the objection to the application under 37 CFR 1.172(a) is deemed to have been overcome and is, therefore, withdrawn.
4. The substitute reissue declaration filed in this application on 24 February 2011 is defective, (see 37 CFR 1.175 and MPEP §1414) because of the following:

It fails to contain the statement required under 37 CFR 1.175(a)(1) as to Applicant's belief that the original patent is wholly or partly inoperative or invalid by reason of (1) a defective specification (or drawing) or (2) by reason of the patentee claiming more or less than the patentee had a right to claim in the patent. See 37 CFR 1.175(a)(1) and see MPEP §1414. In this case, although Applicant has included the statement "by reason of other errors," this statement does not fall within either of the allowed options listed above. In this regard, Examiner deems the errors specified by Applicant to render the patent partly inoperative by reason of claiming more than what patentee had a right to claim, because the patented claims have no support within the originally filed specification (i.e.; there is no disclosed support, satisfying 35 U.S.C. §112, first paragraph, for the patented claim limitation of "performing a comparison of the set of non-recurring records of the first database to a recurring record of the first database"). Such should be specified in the substitute reissue declaration filed in response to this Office action.

In addition, the substitute reissue declaration is not in compliance with 37 CFR 1.63(b)(2), as required by 37 CFR 1.175(a) and MPEP §1414. Specifically, 37 CFR 1.63(b)(2) requires that the oath or declaration must ... State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration. In this case, although Applicant has specified "as amended by any amendment referred to above," no amendments have been specifically referred to. In this regard, both the preliminary

amendments, filed 25 March 2002 and 26 July 2002, need to be referenced in the substitute reissue declaration filed in response to this Office action.

5. Claims 1-49, 51-55, 57 and 58 are rejected as being based upon a defective reissue declaration under 35 U.S.C. §251, as set forth above. See 37 CFR 1.175. The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M.N. VON BUHR whose telephone number is (571) 272-3755. The examiner works a part-time schedule and can normally be reached on Monday and Thursday (9am-7pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/M.N. VON BUHR/  
Primary Examiner, Art Unit 2121